

REMARKS

The present application was filed on April 14, 2000, with claims 1-41. In an Amendment filed February 6, 2004, Applicants canceled claims 1-41, and added new claims 42-65. Claims 42-65 remain pending in the present application. Claims 42 and 53 are the independent claims.

Independent claims 42 and 53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,541,656 to Kare et al. (hereinafter "Kare") in view of PCT International Application WO 98/01982 (hereinafter "Alland"). Each of the dependent claims stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kare and Alland in view of an additional cited reference.

In this response, Applicants traverse the §103(a) rejections, and amend independent claims 42 and 53. Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the remarks below.

Applicants initially traverse the §103(a) rejections on the ground that the Kare and Alland references, even if assumed to be combinable, fail to teach or suggest all the limitations of at least independent claims 42 and 53, and on the further ground that insufficient motivation has been identified for the proposed combination.

Each of independent claims 42 and 53 calls for providing a simulation of a graphical user interface of a digital camera, the simulation being provided on a display device that is separate from the digital camera. There is no such simulation provided in the combined teachings of Kare and Alland. The Examiner relies on the teachings in column 10, lines 46-67, of Kare, as allegedly showing the claimed simulations. See the Office Action at pages 3 and 5. However, there is no teaching in the relied-upon portion of Kare, or in other portions of the cited references, to the effect that a simulation of the graphical user interface of the digital camera is provided. Instead, these portions indicate that the camera can be controlled from a host computer, but do not teach or suggest that the graphical user interface of the digital camera itself is simulated on a separate display device as claimed. Accordingly, the collective teachings of the proposed combination of Kare and Alland fail to meet each and every limitation of claims 42 and 53, as would be required in order to establish a proper *prima facie* obviousness rejection.

Moreover, the proposed combination of Kare and Alland appears to be the product of hindsight-based analysis, since the Examiner fails to provide any objective evidence of motivation for the combination. Alland relates to personal messaging devices, such as pagers, and is therefore believed to be non-analogous art relative to the digital camera art that is the subject of the present invention. In addition, Alland teaches at page 3, lines 29-31, that the purpose of the arrangements described therein is to allow the user of a personal messaging device to "conveniently customize icons to represent different types of messages." In the Kare system, there are no personal paging messages of the type described in Alland, and hence one would not be motivated to apply the Alland teachings to the Kare system. In fact, there is no indication whatsoever in Kare or Alland as to the manner in which the personal paging message icons of Alland could be applied to a fixed LCD display such as LCD 260 in FIG. 9B of Kare, and as noted above the position advanced by the Examiner in this regard seems to be based on subjective, hindsight-based reasoning rather than objective evidence.

Accordingly, the §103(a) rejections based on Kare and Alland are believed to be improper, and should be withdrawn.

Notwithstanding the foregoing traversal, independent claim 42 has been amended to specify that the simulation of the graphical user interface on the display device separate from the digital camera comprises a presentation of the selected one of the plurality of different actuatable versions of at least the given icon with one or more additional icons arranged in substantially the same manner as such icons would appear in the customized graphical user interface of the digital camera. Support for the amendment can be found in the specification at, for example, page 13, line 29, to page 14, line 13.

In an illustrative embodiment described in conjunction with FIGS. 4A and 5 of the present application, it can be seen that icons 362, 364 and 366 of FIG. 5 are presented in simulation window 300 of a display screen 53 of display monitor 52 in host computer 40. The icons 362, 364 and 366 are presented in substantially the same manner that such icons appear in the corresponding FIG. 4A graphical user interface screen of the digital camera 10.

Independent claim 53 has been amended to specify that the simulation of the graphical user interface on the display device separate from the digital camera comprises a presentation of the selected one of the plurality of different available versions of the displayed information arranged in a simulation window in substantially the same manner as such displayed information would appear in the customized graphical user interface of the digital camera. Again, support for the amendment can be found in the specification at, for example, page 13, line 29, to page 14, line 13.

As noted previously, the proposed combination of Kare and Alland fails to teach or suggest the simulation of a graphical user interface of a digital camera on a separate display device. Claims 42 and 53 are therefore believed to define patentable subject matter relative to Kare, Alland and the other art of record.

The dependent claims are believed allowable for at least the reasons identified above with regard to their respective independent claims.

If there are any formal matters remaining after this response, Applicants' attorney would appreciate a telephone call to attend to these matters.

In view of the foregoing, this application is believed to be in condition for allowance, the notice of which is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

A duplicate copy of this communication is enclosed.

Respectfully submitted,



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